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EXAMINER

ROSEN, NICHOLAS D

| ART UNIT | PAPER NUMBER |
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3625

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,533

Applicant(s)

MITSUOKA ET AL.

Examiner

Nicholas D. Rosen

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-9 have been examined.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "delivery business database 9", mentioned on page 31, line 3, and page 33, line 1, does not quite correspond in name to what is shown in the drawings, especially Figures 1, 4, 19, and 24, and the reference number 9 is not found in the figures. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: On page 6, line 5, "oneself" should be "himself", or possibly "herself" or "himself or herself", if Applicant prefers.

Appropriate correction is required.

Claim Objections

Claims 1-6 are objected to because of the following informalities: In the fifth, fourteenth, and eighteenth lines of claim 1 (lines 6, 15, and 19 on page 37), "application IDs" should be "application ID's" if Applicant wishes to conform to standard usage. In the eighth and ninth lines of claim 1 (lines 9 and 10 on page 37), "notifying said application IDs" is unclear, because it could hardly be the ID's (note apostrophe) as such which are notified; presumably, notification is sent to someone, referencing at least one application ID. In the eleventh line of claim 1 (line 12 on page 37), "list of the product" should be "list of the products". Appropriate correction is required.

Claim 2 is objected to because of the following informalities: In the eighth line of the claim (line 4 of page 38), "application IDs" should be "application ID's" if Applicant wishes to conform to standard usage. Appropriate correction is required.

Claim 5 is objected to because of the following informalities: In the sixth line of the claim (line 18 of page 39), "application IDs" should be "application ID's" if Applicant wishes to conform to standard usage. Appropriate correction is required.

Claim 6 is objected to because of the following informalities: In the sixth line of the claim (line 1 of page 40), "application IDs" should be "application ID's" if Applicant wishes to conform to standard usage. Appropriate correction is required.

Claim 7 is objected to because of the following informalities: In the fifth, eleventh, and seventeenth lines of claim 7 (lines 10, 16, and 22 on page 40),

“application IDs” should be “application ID’s” if Applicant wishes to conform to standard usage. In the eighth line of claim 7 (line 13 on page 40), “notifying said application IDs” is unclear, because it could hardly be the ID’s (note apostrophe) as such which are notified; presumably, notification is sent to someone, referencing at least one application ID. Appropriate correction is required.

Claim 8 is objected to because of the following informalities: In the tenth line of claim 8 (line 8 on page 41), “delivery of said products have been made” should be either “delivery of said products has been made” or “deliveries of said products have been made”. In the twenty-first line of claim 8 line 19 on page 41), “held having been corresponded” is ungrammatical, as correspond is not a transitive verb; examiner suggests, “held having been matched”. Appropriate correction is required.

Also regarding claim 8, “said program executing” is not the ideal phrase; “said program operative to cause a computer to carry out the steps of” would be preferable, and an amendment would be cheerfully accepted. However, in context, the only plausible interpretation of “said program executing” is a computer program causing one or more computers to carry out the recited steps, and claim 8 is therefore held to be within the technological arts.

Claim 9 is objected to because of the following informalities: In the eighth line of claim 9 (line 13 on page 42), “have been corresponded” is ungrammatical, as correspond is not a transitive verb; examiner suggests, “have been matched”. Furthermore, the claim is not in the usual format for a method claim, reciting the steps of

"doing A; doing B; doing C; and doing D," for appropriate A, B, C, and D. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a method not within the technological arts ("technological arts" being considered equivalent to "useful arts," mentioned in Article I, Section 8 of the United States Constitution, saying that Congress shall have "power to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writing and Discoveries" – see *In re Musgrave*, 431 F.2d 882, 167 USPQ [CCPA 1970]). The claims are directed to a method that does nothing more than manipulate an abstract idea. To be patentable, a method claim must produce a useful, concrete, and tangible result, or involve a step or act of manipulating technology (see *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ 2d. at 1452). Managing delivery of products may be, in a sense, useful, but is not in itself concrete or tangible.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to a method not within the technological arts ("technological arts" being considered equivalent to "useful arts," mentioned in Article I, Section 8 of the United States Constitution, saying that Congress

shall have "power to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writing and Discoveries" – see *In re Musgrave*, 431 F.2d 882, 167 USPQ [CCPA 1970]). The claims are directed to a method that does nothing more than manipulate an abstract idea. To be patentable, a method claim must produce a useful, concrete, and tangible result, or involve a step or act of manipulating technology (see *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ 2d. at 1452). A delivery information service method may be, in a sense, useful, but is not in itself concrete or tangible.

Although claim 9 recites an address table, this need not necessarily be part of an electronic database, and claim 9 does not recite computer-implemented or other technological manipulation of the table in carrying out the steps of referring to the address table and extracting a notification address.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 5, 6, and 7

Claims 1, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tartal et al. (U.S. Patent Application Publication 2004/0039712) in view of official notice. As per claim 1, Tartal discloses a method for managing delivery of products that have been ordered, including: an application accepting step of accepting applications for delivery of said products from a provider of said products (Abstract; paragraphs 10 and 25); an assigning step of assigning application ID's to said applications (paragraphs 10, 25, and 35); prompting step of prompting a recipient to designate delivery terms by referencing at least one application ID (paragraphs 25 and 35); and a term accepting step of accepting designation of delivery terms for the application(s) specified by said application ID's from said delivery recipient after orders of said products (paragraphs 30-37). Tartal does not expressly disclose a presenting step of presenting said delivery recipient with a list of the products scheduled to be delivered to said delivery recipient and said application ID, although this can be considered as disclosed if a list with one item is still a list (paragraphs 21-26). However, the duplication of known parts is held to be obvious to one of ordinary skill in the art (*St. Regis Paper Co. vs. Bemis Co.*, 193 USPQ 8, 11; 549 F. 2nd. 833 (7th Circuit 1977); *In re Harza*, 124 USPQ 378, 380; 274 F. 2nd. 269, CCPA (1960)). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to present said delivery recipient

a list of products scheduled to be delivered, for the obvious advantage of making arrangements for delivery when more than one product was involved.

Similarly, Tartal discloses a requesting step of making a request for delivery by notifying a delivery business of the product corresponding to an application ID for which a delivery term has been requested, of the designated delivery term, and of the delivery recipient, but not doing this for a plurality of products for which the same delivery term has been designated (Abstract; paragraphs 10 and 30). Even reading an explicit limitation to a plurality of products into this clause, the duplication of known elements is held to be obvious, and official notice is taken that it is well known to deliver a plurality of products together. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to make a request for delivery of a plurality of products with the same delivery terms, for the obvious advantages of reducing the number of trips required of a delivery service, and the number of days when a recipient must wait at home to receive products.

As per claim 5, Tartal discloses a user judging step of judging whether said delivery recipient is the party that ordered said product(s) (paragraphs 23 and 24). Tartal does not disclose a notifying step of notifying the provider of said products that the products specified by said application ID's have been purchased after said term accepting step, according to a result of said user judging step, but official notice is taken that it is well known to notify product providers that products have been purchased. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the

time of applicant's invention to notify the provider as claimed, for the obvious advantage of arranging for the shipping and delivery of ordered products.

As per claim 6, Tartal discloses a user judging step of judging whether said delivery recipient is the party that ordered said product(s) (paragraphs 23 and 24); and a cancel accepting step of accepting cancellations of orders (or at least deliveries) for said products specified by said application ID's (paragraphs 31 and 32); and a cancel notifying step of notifying the provider of said products for which the order specified by said application has been cancelled, according to a result of said user judging step (paragraphs 31 and 32) (returning the products to the sender is held to constitute notification).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tartal et al. (U.S. Patent Application Publication 2004/0039712) in view of official notice. Claim 7 is closely parallel to claim 1, and rejected on essentially the same grounds.

Claims 8 and 9

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tartal et al. (U.S. Patent Application Publication 2004/0039712) in view of Piggins (U.S. Patent Application Publication 2002/0046153) and official notice. Tartal discloses a delivery information service method, including: receiving a delivery request for an article (Abstract; paragraph 21), and storing a received delivery request in a storage device (paragraphs 24-26). Tartal does not disclose searching a storage device for pending deliveries with the same delivery recipient as the delivery recipient of said delivery

request, but Piggins teaches searching a customer profile for relevant items (paragraphs 6, 13, and 14). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to search the storage device for pending deliveries with the same delivery recipient, for the obvious advantage of arranging the delivery of desired products.

Tartal does not expressly disclose referring to an address table and extracting the notification address of the delivery recipient, but being able to make deliveries implies possessing addresses, and official notice is taken that it is well known to maintain files of people's addresses, and extract the addresses therefrom. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to refer to an address table and extract the notification address therefrom, for the obvious advantage of delivering the article or articles to the correct the address.

Tartal discloses that, based on desired delivery terms, instructions are made for delivery to the delivery recipient of the article scheduled for delivery, said instructions being given to a delivery business that has been designated by the desired conditions or that matches desired conditions (Abstract; paragraphs 26, 30, 37, and 38).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tartal et al. (U.S. Patent Application Publication 2004/0039712) in view of Piggins (U.S. Patent Application Publication 2002/0046153) and official notice. Claim 8 recites, in essence, a computer program for carrying out the method of claim 9, and is therefore rejected on essentially the grounds set forth above with regard to claim 9.

Allowable Subject Matter

Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and further rewritten to be placed clearly within the technological arts, overcoming the rejection under 35 U.S.C. 101.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Tartal et al. (U.S. Patent Application Publication 2004/0039712), discloses or makes obvious the limitations of claim 1, as set forth above. However, neither Tartal nor any other prior art of record discloses, teaches, or reasonably suggests a group accepting step of accepting formation of a group and designation of group members from said delivery recipients; and said prompting step further including a group notification step of giving notification of a list of products scheduled for delivery to other members of the group to which the delivery recipient belongs, and the application ID's therefor. It is known to accept formation of a group and notify the members of such a group (e.g., forming an e-mail list, and sending a post to all members of such a list), and it is known to leave a message and/or a package with a neighbor if the intended recipient of a package isn't available when the deliveryman comes by, but these do not suffice to teach the recited limitations.

Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of

the base claim and any intervening claims, and further rewritten to be placed clearly within the technological arts, overcoming the rejection under 35 U.S.C. 101.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Tartal et al. (U.S. Patent Application Publication 2004/0039712), discloses or makes obvious the limitations of claim 1, as set forth above. Tartal does not expressly disclose that said application accepting step further includes a step of accepting an application for delivery of a first product of said products and an application for delivery of a second product of said products, with corresponding first and second delivery terms, but it is well known to order multiple products. However, Tartal does not disclose a judging step of judging whether prior to delivery of the first product, a second delivery term is designated for the second product; and a term changing step of changing the first delivery term set for the first product to the second delivery term set for the second product according to a result of the judging step (nor the slightly different limitations of claim 4). No other prior art of record discloses, teaches, or reasonably suggests these limitations. The closest prior art for these limitations is Kawasaki (Japanese Published Patent Application 11-272752 A), and Kawasaki, although related to the modification of delivery dates, does not teach the limitations recited in either claim. It would be surprising if no one had thought to deliver two products to the same recipient together, even if they might otherwise have been delivered at the same time, but doing so is not held to meet the detailed limitations of claims 3 or 4.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ross (U.S. Patent 5,648,770) discloses an apparatus and method of notifying a party of a pending delivery or pickup. Doyle et al. (U.S. Patent 5,694,551) discloses a computer integration network for channeling customer orders through a centralized computer to various suppliers (note columns 3 and 5). Tsukuda (U.S. Patent 6,085,170) discloses a delivery managing system. Soga et al. (U.S. Patent 6,304,856) discloses a freight information management method and system.

Hamada (Japanese Published Patent Application 4-106657-A) discloses a physical distribution system. Kawasaki (Japanese Published Patent Application 11-2272752-A) discloses a product completion and delivery schedule management apparatus.

The anonymous article, "American Freightways Announces Latest Web-Site Enhancements," discloses scheduling customer notification when shipments reach a predetermined status. The anonymous article, "Post Office Pitches for Internet Shoppers," discloses enabling consumers to choose their own delivery times. The anonymous article, "Shipping and Freight Forwarding Information Accessible Online," discloses allowing delivery schedules, etc., to be checked online. The anonymous article, "Nextel Introduces Nextel Online(SM): Wireless Internet Service for Business," discloses enabling customers to check the status of pending orders. Knill, B., "Crossdocking Gets Smarter," discloses tracking orders being shipped.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Draft/non-official communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER

November 10, 2004